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Mark E. Sanders

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MAGINOT, MOORE & BECK, LLP

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK E. SANDERS,
Appellant

Appeal 2008-1283
Application 10/039,717
Technology Center 3600

Decided: July 16, 2008

Before JAMESON LEE, RICHARD TORCZON, and SALLY C.
MEDLEY, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

DECISION ON APPEAL

A. Statement of the Case

This is a decision on appeal by an Appellant under 35 U.S.C. § 134(a) from a final rejection of claims 1-9. We have jurisdiction under 35 U.S.C. § 6(b).

References Relied on by the Examiner

Scott	Re. 29,945	Mar. 27, 1979
Igarashi et al.	JP 5-71217	Mar. 23, 1993

The Rejections on Appeal

The Examiner rejected claims 1-4 under 35 U.S.C. § 103(a) as unpatentable over Scott.

The Examiner rejected claims 5-9 under 35 U.S.C. § 103(a) as unpatentable over Scott and Igarashi et al. (“Igarashi”).

B. Issue

Has the Appellant shown error in the rejections of claims 1-9?

C. Summary of the Decision

The Appellant has shown error in the rejection of claims 1-9.

D. Findings of Fact

1. The invention relates to a device for protecting a concrete slab during pouring of an adjacent slab by providing a slab protector in the form of a sheet of material configured to overlap an edge of the slab. (Spec. ¶¶ 1 and 7.)

2. Claim 1 is the sole independent claim and is reproduced below (Claims App’x., p. 11):

1. A device for protecting at least a portion of a poured slab during activity at a site adjacent the poured slab, said device comprising a sheet including:

a primary portion sized to extend substantially along the entire width of the slab and to cover a portion of the upper surface of the slab adjacent an exposed side of the slab;

an overhang portion sized to cover a portion of the side of the slab; and

a fold portion connecting said primary portion to said overhang portion at an angle configured so that said overhang portion substantially abuts the side of the slab when said primary portion is resting on the surface of the slab.

3. Scott discloses a multiple use concrete form liner that functions to impart a design arranged on the face of the liner to the surface of concrete. (Scott Title and 3:37-41.)

4. As shown in Figure 4 of Scott, the concrete form liner is formed by liner panels 43, 44, 45, and 46.

5. The liner panels 43, 44, 45, and 46 are fastened to a concrete form that is formed by panels 40, 41, and 42. (Scott 2:4-8 and 7:26-28.)

6. The liner panels 43, 44, 45, and 46 are made of a material sufficiently soft such that when one panel is placed next to another they squeeze together to close the joints between them. (Scott 7:37-40.)

7. The concrete form panels 40, 41, and 42 are made of “such materials as plywood, steel and the like” (Scott 5:1-2) and serve as the means to support the concrete (Scott 3:28-29; 5:2-7; 7:19-25).

8. Scott does not describe arranging any fold portion in the liner panels 43, 44, 45, and 46 when they are attached to the concrete form panels 40, 41, and 42.

E. Principles of Law

Obviousness is a legal determination made on the basis of underlying factual inquiries including (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

The initial burden is on the examiner to establish a prima facie basis to reject the claims. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). The examiner must provide a factual basis to support an obviousness conclusion. *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) (the examiner may not resort to speculation, assumptions, or hindsight reconstruction).

F. Analysis

Claims 1-9 stand or fall together. (App. Br. 3:14-15.) We need only address the rejection of representative claim 1.

Claim 1 calls for each of a primary portion and an overhang portion that are connected at an angle by a fold portion so that the overhang portion abuts the side of a slab when the primary portions rests on the surface of the slab. The Examiner identified liner panels 43 and 44 of Scott as a primary portion and liner panels 45 and 46 as an overhang portion. (Ans. 3:3-4.) The Examiner further determined that “Scott discloses [a] multi use concrete form liner with perforations and bends/fold 50/51/52; see figure 4” (Ans. 3:2-3) and specifically identified “fold portion 51” (Ans. 3:4) to satisfy the fold portion limitation of the Appellant’s claim 1. The Appellant disputes that Scott discloses primary and overhang portions with a fold portion connecting said primary portion to said overhang portion as required by claim 1. (App. Br. 7:2-10.) The Appellant argues that none of the joints 50,

51, or 52 that have been identified by the examiner forms a fold portion as claimed. We agree with the Appellant.

We address first the Examiner's reliance on joint 51, which was termed by the Examiner a "fold portion." (Ans. 3:4.) Scott discloses a series of three concrete form panels 40, 41, and 42 arranged side-by-side in abutting relationship and multiple liner panels 43, 44, 45 and 46 arranged on the concrete form panels. (Scott 7:26-28 and Figure 4.) Joint 51 is arranged between the separate concrete form panels 40 and 41 (Scott 7:33-34). That joint is not described as a fold portion. There is no suggestion in Scott for that joint to be regarded as a fold portion. Moreover, the joint 51 is arranged between the concrete form panels 40, 41, and 42, and does not form any part of the liner panels 43, 44, 45, and 46. It is the liner panels and not the concrete form panels that are relied on by the Examiner to form the claimed primary and overhang portions. (Ans. 3:3-4.) Thus, the joint 51 between the concrete form panels cannot form a "fold portion connecting said primary portion to said overhang portion" as required by claim 1.

Turning to joints 50 and 52, they serve as the points of connection between, respectively, liner panels 43 and 44 and liner panels 45 and 46. (Scott Fig. 4.) Scott does not describe either of those joints as fold portions. Instead, each of the joints 50 and 52 are simply the gap or separation between multiple liner panels that is eventually closed by squeezing together the liner panels. (Scott 7:37-39.) There is no suggestion that those joints are folded or would form a "fold portion connecting said primary portion to said overhang portion at an angle configured so that said overhang portion substantially abuts the side of the slab when said primary portion is resting on the surface of the slab" as required by claim 1.

Furthermore, we also disagree with the Examiner's finding that the liner of Scott may be simply divided into three portions that are termed the primary, overhang, and fold portions in order to satisfy the Appellant's claim 1. (Ans. 4:22 to 5:3.) Claim 1 explicitly calls for "a fold portion connecting said primary portion to said overhang portion at an angle configured so that said overhang portion substantially abuts the side of the slab..." (Claims App'x., 11.) That limitation defines a distinct structural element that causes the overhang portion to abut the side of the slab. The liner of Scott does not show such a fold portion connecting any other portion of the liner at an angle to abut the side of a concrete slab nor has any teaching been identified to create such a fold portion.

The initial burden is on the examiner to establish a prima facie basis to reject the claims. *In re Oetiker*, 977 F.2d at 1445. The examiner must provide a factual basis to support an obviousness conclusion. *In re Warner*, 379 F.2d at 1017 (the examiner may not resort to speculation, assumptions, or hindsight reconstruction).

For the above-noted reasons, we do not find that the Examiner has established a prima facie case of obviousness to support the rejection of claim 1 over Scott. Therefore, we do not sustain the rejection of claims 1-9 under 35 U.S.C. § 103(a) as unpatentable over the applied prior art.

New Grounds of Rejection

Pursuant to 37 C.F.R. § 41.50(b), the following new grounds of rejection are applied to the Appellant's claim 1:

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 that forms the basis for the rejections under this section set forth below:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States....

Claim 1 is rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 1,954,554 to Angier (“Angier ‘554”).

Angier ‘554 discloses a concrete cover for curing and protecting a concrete layer. (Angier ‘554, 1:1-7.) The cover satisfies the recitation of a “device for protecting at least a portion of a poured slab during activity at a site adjacent the poured slab.”

The cover comprises a sheet that includes a primary portion formed either by a plurality of strips or of a single width (Angier ‘554, 1:52-56). In describing multiple strips 1, 2, and 3, Angier ‘554 provides that the strips are “of convenient width for manufacturing purposes for the average 10’ strip of concrete.” (Angier ‘554, 1:72-75.) The cover is also described as being “made of appropriate dimensions to substantially fit or cover the section of road surface being built...” (Angier ‘554, 1:16-18.) The cover satisfies the claim limitation of “a primary portion sized to extend substantially along the entire width of the slab and to cover a portion of the upper surface of the slab adjacent an exposed side of the slab.”

The cover further includes an overhang portion (either flange portion 10) that is connected to the edge of each of the outermost strips 1 and 3.

(Angier '554, 1:81-84.) The flange portions 10 are pulled out to form surfaces that abut the concrete layer 20 (Angier '554, 1:94-95 and Figure 1) and serve to cover and protect opposite edges of the concrete being laid. (Angier '554, 1:56-60.) The flange portions 10 satisfy the claim limitation of "an overhang portion sized to cover a portion of the side of the slab."

Once the flange portions 10 are pulled out, an "upturned hand holding ridge, or rim" is formed between the flange portions 10 and the surface covering portion 1, 2, and 3 "when the depending flange is fitted on the adjacent edge portion of the concrete." (Angier '554, 1:63-66.) That protecting ridge 21 and its relationship to the flange portion 10 and surface cover 1, 2, and 3 satisfy the claim limitation of "a fold portion connecting said primary portion to said overhang portion at an angle configured so that said overhang portion substantially abuts the side of the slab when said primary portion is resting on the surface of the slab."

Alternatively, claim 1 is rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 2,003,988 to Angier ("Angier '988").

Angier '988 discloses a sheet material cover for curing and protecting concrete road surfaces. (Angier '988, Title and 1:7-10.) The cover satisfies the recitation of a "device for protecting at least a portion of a poured slab during activity at a site adjacent the poured slab."

The cover comprises a sheet formed by a plurality of strips 2, 3, and 4. Those strips are connected to one another to form a protecting mat (Angier '988, 1:21-26) that covers the top surface of a concrete roadway (Angier '988, 1:12-15). The connected strips satisfy the claim limitation of "a primary portion sized to extend substantially along the entire width of the

slab and to cover a portion of the upper surface of the slab adjacent an exposed side of the slab.”

The cover further includes flanges 5 and 6 that are shown in a depending position in Figure 1. (Angier ‘988, 1:30-32.) In that position, the flanges cover and protect the sides of the concrete roadway. (Angier ‘988, 1:13-15.) The flange portions 5 and 6 satisfy the claim limitation of “an overhang portion sized to cover a portion of the side of the slab.”

Once the flange portions 5 and 6 assume the depending position, a fold portion is formed that connects those flange portions and the primary portion formed by the strips 2, 3, and 4 at an angle. (Angier ‘988, Figure 1.) When the cover is placed on the concrete, the flange portions serve to cover the edges of the concrete. (Angier ‘988, 1:29-32.) The arrangement of the fold portion, flange portions, and primary portion satisfies the claim limitation of “a fold portion connecting said primary portion to said overhang portion at an angle configured so that said overhang portion substantially abuts the side of the slab when said primary portion is resting on the surface of the slab.”

G. Conclusion

The rejection of claims 1-4 under 35 U.S.C. § 103(a) as unpatentable over Scott is **reversed**.

The rejection of claims 5-9 under 35 U.S.C. § 103(a) as unpatentable over Scott and Igarashi is **reversed**.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). That section provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of

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the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner....

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record....

REVERSED

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